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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,481	01/20/2006	Pierre Barberis	12467/8	2123
23280 7590 09/11/2008 Davidson, Davidson & Kappel, LLC 485 7th Avenue 14th Floor New York, NY 10018				
EXAMINER PALABRICA, RICARDO J				
ART UNIT 3663		PAPER NUMBER		
MAIL DATE 09/11/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,481

Applicant(s)

BARBERIS ET AL.

Examiner

Rick Palabrica

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-29 is/are pending in the application.
- 4a) Of the above claim(s) 17, 19-21 and 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's 5/30/08 Amendment, which directly amended claim 23 and traversed the rejection of claims in the 2/28/08 Office action, is acknowledged.

Applicant's arguments regarding the rejected claims have been fully considered but they are not persuasive.

Response to Arguments

2. Applicant traversed applied art, Mardon, on the grounds that: a) he does not teach "a rolled flat arrangement"; b) his "tubes are drawn into blanks and would result not result in the same structure or in the claimed 'reduction ratio of 2 to 20 percent.'"

The examiner disagrees.

As to argument a):

First, Mardon has not been applied for a teaching on the so-called flat arrangement because such configuration is already taught in the primary reference, i.e., APA. Instead, the teaching in Mardon that was used to modify the APA is on the performance of a single rolling sequence without intermediate annealing. Thus, applicant's arguments are unpersuasive because the applicant has not shown that the references do not teach what the examiner has stated they teach, nor, has the applicant shown that the examiner's reasoning for and manner of combining the teachings of references is improper or invalid.

Second, the form of a specimen subjected to cold rolling, i.e., either a tube (as in Mardon) or a flat product (as in APA and applicant's case), is immaterial because the crystallographic orientation of a tube (or plate) prepared for said cold rolling is the same, i.e., it is in a normal-to-plate (or tube) surface direction (see, for example, Inagaki et al. [U.S. 5,297,177]).

As to argument b), again the teaching on a flat structure comes from the APA and not from Mardon. As to the reduction ratio of 2 to 20 percent, as stated in section 5 of the 2/28/08 Office action, the degree of reduction is a design requirement that depends on the final dimensions of the final product, as specified by the user.

3. Applicant traversed applied art, Graham and Katz, on the ground that, "[i]t would not have been obvious to one of skill in the art to combine the references of Mardon et al. with Graham or Katz to achieve the claimed reduction ratio in view of the tube shaped structure." The examiner disagrees.

Graham or Katz was not applied for a teaching on achieving the claimed reduction ratio. Instead, they were used for a teaching that the zirconium alloy material in Mardon can be used as cladding material for nuclear fuel elements having either a flat plate or a tube configuration. See section 5 in the 2/28/08 Office action. Again, applicant's arguments against Graham or Katz are unpersuasive because the applicant has not shown that the references do not teach what the examiner has stated they teach, nor, has the applicant shown that the examiner's reasoning for and manner of combining the teachings of references is improper or invalid.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16, 18, and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (APA) in view of Mardon et al. (U.S. 5,735,978) alone or in combination with either one of Graham (U.S. 3,336,201) or Katz (U.S. 3,776,508).

As to claims 16, 18, 22, and 24-26, the reasons are the same as those stated in section 5 of the 2/28/08 Office action, as further clarified in sections 2 and 3 above, which reasons are herein incorporated.

As to claim 23, just like claim 22, the reduction ratio of 5% to 10%, this is matter of design, as discussed in section 5 of the 2/28/08 Office action and in section 2 above.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:00-4:30, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 8, 2008

/Rick Palabrica/
Primary Examiner, Art Unit 3663